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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/056,790 | 01/23/2002 | Mario N. Lioubin | EX02-004C | 1603 |

23500 7590 11/16/2004

PATENT DEPT
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EXAMINER

YAEN, CHRISTOPHER H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1642

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,790

Applicant(s)

LIOUBIN ET AL.

Examiner

Christopher H Yaen

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RE: Lioubin et al

1. In view of the petition decision mailed 10/12/2004, the finality of the instant application is withdrawn, in favor of a new restriction requirement, set forth hereto.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP1 polypeptide and its binding target, classified in class 435, subclass 5.
 - II. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP2 polypeptide and its binding target, classified in class 435, subclass 5.
 - III. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP3 polypeptide and its binding target, classified in class 435, subclass 5.
 - IV. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP4 polypeptide and its binding target, classified in class 435, subclass 5.
 - V. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP5 polypeptide and its binding target, classified in class 435, subclass 5.

- VI. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP6 polypeptide and its binding target, classified in class 435, subclass 5.
- VII. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP7 polypeptide and its binding target, classified in class 435, subclass 5.
- VIII. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between RRP8 polypeptide and its binding target, classified in class 435, subclass 5.
- IX. Claims 8-12, drawn to a method of screening for an agent that modulates the interaction between mRRP1 polypeptide and its binding target, classified in class 435, subclass 5.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The instant specification does not disclose that these methods would be used together. The method of screening for agents that modulate the interaction between RRP1-8 and mRRP1 are all unrelated as they comprise distinct steps because they utilize different products (i.e. RRP1-RRP8, or mRRP1) which demonstrates that each method has a different mode of operation. Each invention performs this function using a structurally and functionally divergent material, as exemplified by the identification of each molecule

by a specific sequence identification number. Therefore, each method is divergent in materials and thus differ in the practice of the each step. For these reasons the Inventions of groups I-IX are patentably distinct.

Although the inventions of Groups I-IX are classified in the same class and subclass, the distinct steps and products require separate and distinct searches. As such, it would be burdensome to search the inventions of Groups I-IX together.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Chrisp HZ", with a long horizontal flourish extending to the right.

Christopher Yaen
Art Unit 1642
November 15, 2004